

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CATHERINE SHOEMAKER

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Appeal No. 2003-2062  
Application 09/853,568

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ON BRIEF

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**MAILED**

**DEC 31 2003**

**PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Before COHEN, FRANKFORT, and BAHR, Administrative Patent Judges.  
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4 through 11 and 13 through 21, all of the claims remaining in this application. Claims 3 and 12 have been canceled.

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As noted on page 1 of appellant's specification, the present invention relates to

a marking system and apparatus for containers using icons to identify and represent the desired use for the contents. More specifically, the present invention relates to a graphical marking apparatus and method for medicine receptacles whereby iconic decals are applied to the medicine receptacles to assist in identifying the contents or whereby graphical representations are created on or in the perimeter of or covering to the receptacle.

Independent claims 1, 7, 11, 17 and 19 are representative of the subject matter on appeal, and a copy of those claims can be found in the Appendix to appellant's brief.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Mayfield	5,261,702	Nov. 16, 1993
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Claims 1, 2 and 17 through 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mayfield.

Claims 4 through 11, 13 through 16, 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mayfield.

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Rather than reiterate the examiner's statement of the above-noted rejections and the conflicting viewpoints advanced by appellant and the examiner regarding those rejections, we refer to the answer (Paper No. 14, mailed February 25, 2003) for the examiner's reasoning in support of the rejections and to the brief (Paper No. 13, filed January 24, 2003) for appellant's views to the contrary.

#### OPINION

Our evaluation of the issues raised in this appeal has included a careful assessment of appellant's specification and claims, the applied prior art Mayfield reference, and the respective positions advanced by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Turning first to the examiner's rejection of claims 1, 2 and 17 through 19 under 35 U.S.C. § 102(b) based on Mayfield, we will sustain the rejection of claims 1, 2, 17 and 18, but not that of claim 19. Like the examiner, we are of the view that the depictions in Figures 4, 5 and 7 of the Mayfield patent and the

descriptions thereof at column 7, lines 31-46, clearly teach a receptacle of the type set forth in claim 1 on appeal and an iconic label (22) as defined in both claims 1 and 17 comprising a descriptive, non-textual icon/marker which graphically describes or identifies the medicine in the container and that, over time, will do so without reference to another source, such as the chart (10) shown in Figure 2 or the chart mentioned in column 7, lines 58-64, of Mayfield. In that regard, we consider that the chart (10) and the chart described in column 7 of the Mayfield patent are each merely an educational device, which after a sufficient period of time will not be needed by the user, because the user will have by then been educated to immediately recognize and understand that a particular icon used for the same medication for an extended period of time identifies or describes that particular medication, its uses, the ailment or symptoms treated by the medication, directions for taking the medication, any cautions or side effects, etc.

Our conclusion in this regard is bolstered by appellant's disclosure of what would appear to be the exact same type of iconic label in the paragraph bridging pages 6-7 of the present specification, wherein it is indicated that

iconic labels 30 need not be pictorial, but rather may be colored or other symbols such as a blue circle or a red square. While these colored symbols may not immediately be associated with a particular medicine or use, the patient will associate the colored symbols with certain medicine or uses much more quickly than a purely textual label.

With respect to dependent claims 2 and 18 on appeal, it is clear from Mayfield (Figs. 4-5) that the markers/labels (22) are disposed on an external surface of the medicine receptacle/housing, and that the marker/label (22) is an icon which contains no alphanumeric characters.

Appellant's arguments in the brief (pages 6-8) do nothing to alter our view of Mayfield as expressed above. Once educated by repeated use of the same icon for the exact same medication for a sufficient period of time (weeks, months or years), we are convinced that most users would come to recognize that icon as identifying or describing a particular medication and its uses, etc., without reference to another source. Likewise, after such repeated use, the icon itself becomes descriptive of the medication because of the mental association a long term user makes regarding the particular medication that icon represents.

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Given the foregoing, we will sustain the examiner's rejection of appellant's claims 1, 2, 17 and 18 under 35 U.S.C. § 102(b).

Claim 19 differs from the claims noted above, in that it sets forth a device for describing the medicine contained in a medicine receptacle, wherein the device comprises "a label having a picture that alone identifies the medicine." As urged by appellant on pages 8-9 of the brief, no such label with a picture that alone identifies the medicine is shown or described in Mayfield. The marker/label (22) of Mayfield in the shape of a given symbol and/or in a particular color is not "a label having a picture that alone identifies the medicine" (emphasis added). Thus, the examiner's rejection of claim 19 under 35 U.S.C. § 102(b) as being anticipated by Mayfield will not be sustained.

We next look to the examiner's rejection of claims 4 through 11, 13 through 16, 20 and 21 under 35 U.S.C. § 103(a) based on Mayfield. Claims 4 through 6, which depend from claim 1, further define the type of information or characteristic which the iconic label may depict, i.e., the reason why the medicine is being used, the results of the consumption of the medicine by a

patient, or the symptoms which the consumption of the medicine by a patient is expected to alleviate. Independent claim 7 sets forth a method for marking a medicine receptacle by affixing a label about the exterior of the receptacle, wherein the label contains a descriptive, non-textual iconic representation that describes the medicine. Claims 8 and 9, which depend from claim 7, are like claims 5 and 6 discussed above. Dependent claim 10 adds the requirement that the receptacle of claim 7 must have a cover and the step of affixing the label to the cover. Independent claim 11 defines an icon for marking a medicine receptacle wherein the icon comprises a label with an adhering surface on one side and an external printable media on the other, and a descriptive graphic conveying to a patient the type of medicine within the receptacle. Claims 13 through 16, which depend from claim 11, are like claims 4 through 6 described above.

While the examiner has urged that the subject matter of these claims would have been obvious to one of ordinary skill in the art because it would have been obvious to provide any type of graphic representation on the receptacle cover, since it would only depend on the intended use of the assembly and the desired

information to be displayed, and also invoked the "printed matter" doctrine to dispose of these claims (answer, pages 4-5), we find no need to resort to such approaches, since Mayfield alone discloses the subject matter of claims 4 through 11 and 13 through 16 on appeal. In that regard, we again note that after repeated use of the same icon for the exact same medication for a sufficient period of time (e.g., weeks, months or years), we are convinced that most users would come to recognize that icon as identifying or describing a particular medication, its uses, symptoms treated, results of its consumption, etc., without reference to another source. Likewise, after such repeated use, the icon itself would be understood as being descriptive of the particular medication because of the fact that a long term user would immediately make a mental association regarding the particular medication the icon represents. We again make note that appellants's own specification, in the paragraph bridging pages 6 and 7, supports this conclusion.

As has been made clear by our reviewing Courts on numerous occasions, anticipation or lack of novelty is the ultimate or epitome of obviousness. See, in this regard, In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson,



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494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Accordingly, we will sustain the examiner's rejection of claims 4 through 11 and 13 through 16 under 35 U.S.C. § 103(a) based on Mayfield alone.

Claims 20 and 21 depend from claim 19 and provide further limitations on the "picture" carried by the label defined in claim 19. As we noted above, nothing in the Mayfield patent teaches or suggests a device like that in claim 19 in the form of a label having a picture thereon that alone identifies the medicine in the receptacle. It follows that Mayfield also does not teach or suggest the more specific form of the picture as set forth in dependent claim 20 and 21 on appeal, particularly wherein the picture "depicts the body part for which the medicine is being used" (claim 21). Thus, we will not sustain the examiner's rejection of claims 20 and 21 under 35 U.S.C. § 103(a) based on Mayfield.

We summarize our treatment of the examiner's rejections as follows:

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The examiner's rejection of claims 1, 2 and 17 through 19 under 35 U.S.C. § 102(b) as being anticipated by Mayfield, has been sustained as to claims 1, 2, 17 and 18, but not with regard to claim 19;

The examiner's rejection of claims 4 through 11, 13 through 16, 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Mayfield, has been sustained with respect to claims 4 through 11 and 13 through 16, but not with respect to claims 20 and 21.

As should be apparent from the foregoing, the decision of the examiner is affirmed-in-part.

In addition to the above determinations, we REMAND this application to the examiner for further search. In particular, we note the attached information regarding a number of SUDAFED products, obtained from the Internet, wherein each of the products show a label on a medicine receptacle having a picture which alone broadly identifies the medicine in the medicine receptacle and wherein the picture depicts why the medicine is being used and depicts a body part for which the medicine is being used. The examiner should ascertain an appropriate date

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for such product label representations and determine their prior art status. The examiner should also look to other products found at a drug store with similar representations on the medicine receptacle or label thereof, such as arthritis medicines, joint supplements, antacid medications, dry eye or contact lens treatments, hand creams, nasal decongestants, etc. One particular product of interest in this regard is the liquid form of PEPTO-BISMAL which includes a picture of a stomach and digestive tract on the label of the bottle which are colored pink like the product in the bottle, and which depiction has been used for many years to represent, describe or identify that particular medication and its use, etc.

The decision of the examiner is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand. 37 CFR § 1.196(e) provides that

[w]henver a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

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Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . .


The effective date of this decision is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejection is overcome. If the proceedings before the examiner does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

This application, by virtue of its "specials" status, requires immediate action, see MPEP § 708.01 (Eighth Edition, Revised August 2001). Further, it is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

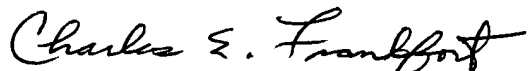
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No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

AFFIRMED-IN-PART AND REMANDED



IRWIN CHARLES COHEN )  
Administrative Patent Judge )



CHARLES E. FRANKFORT )  
Administrative Patent Judge )

) BOARD OF PATENT

) APPEALS AND

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